



Paper No. 7

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OFFICE OF PETITIONS

In re Application of  
Zura et al.  
Application No. 10/036,656  
Filed: December 21, 2001  
Attorney Docket No. 23555-P011US

DECISION DISMISSING PETITION

This is a decision on the petition under 37 CFR 1.47(a), filed on April 2, 2002,<sup>1</sup> requesting that 2 inventors be allowed to file the application on behalf of themselves and of the joint-inventor who allegedly refuses to join in this application, as well as the remaining joint-inventor who allegedly cannot be located.

The petition is **DISMISSED**.

### **Background**

There are 4 joint-inventors for the claimed invention in this application: Christopher P. Zura ("Zura"), Robert Bennet Stout ("Stout"), Jonathan Robert Guthrie ("Guthrie"), and Chris David Duhon ("Duhon"). As pointed out in the February 5, 2002 Notice to File Missing Parts of Nonprovisional Application ("2/5/02 Notice"), the application as filed on December 21, 2001 did not include a properly signed oath or declaration as required by 37 CFR 1.51(b)(2) and as specified in 37 CFR 1.63. In response, the instant petition was filed.<sup>2</sup> The Office of Initial Patent Examination (OIPE) processed the petition and the accompanying declaration ("4/2/02 Declaration") and, as explained below, issued a Notice of Incomplete Reply (Nonprovisional) on April 10, 2002 ("4/10/02 Notice").

### **The 4/2/02 Declaration**

The petition requests that the 4/2/02 Declaration, signed only by Zura and Guthrie, be accepted, alleging that Stout refuses to join in this application and that Duhon cannot be located. Although the 4/2/02 Declaration is signed by Zura and Guthrie,<sup>3</sup> and identifies each of them by the full

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<sup>1</sup> The 4/2/02 petition was supplemented on 6/5/02 with additional statements submitted by facsimile.

<sup>2</sup> The 2-month period for responding to a Notice to File Missing Parts is not identified on the Notice as a statutory period subject to 35 U.S.C. 133. Thus, extensions under 37 CFR 1.136(a) of up to 5 months, i.e., through 9/5/02 at the maximum, are permitted. See MPEP 710.02(d) (Aug. 2001).

<sup>3</sup> 37 CFR 1.63(a)(1).

name,<sup>4</sup> the country of citizenship,<sup>5</sup> and the residence,<sup>6</sup> it does not contain any information on Stout and Duhon, rendering it incomplete within the meaning of 37 CFR 1.63. Therefore, the 4/10/02 Notice was not mailed in error and will not be vacated.

Consequently, the Office is not able to reach the merits of the instant petition under 37 CFR 1.47(a), in that, it fails to meet the threshold requirement for a petition under 37 CFR 1.47(a), i.e., it does not include a complete oath/declaration **identifying each inventor** in accordance with 37 CFR 1.63.<sup>7</sup> The petition is thus dismissed.

A renewed petition under 37 CFR 1.47(a) must:

- include a proper oath/declaration **identifying each of** Zura, Stout, Guthrie, and Duhon in accordance with 37 CFR 1.63, even though Zura and Guthrie may be the only signing inventors;<sup>8</sup>
- be filed before abandonment of this application,<sup>9</sup> along with the appropriate extension-of-time fee;<sup>10</sup>

and should be addressed as follows:

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<sup>4</sup> 37 CFR 1.63(a)(2).

<sup>5</sup> 37 CFR 1.63(a)(3).

<sup>6</sup> 37 CFR 1.63(c).

<sup>7</sup> Regardless of whether the named inventor signs the oath/declaration.

<sup>8</sup> **A blank declaration is attached for counsel's use** (The 4/2/02 Declaration is unacceptable also because each page signed by the inventor contains only of information on that inventor. To each signing inventor, there is no indication of other joint-inventors named in the application.).

The statement of facts does not need to be re-submitted, unless counsel wishes to provide supplemental information.

No petition fee is required.

<sup>9</sup> The original reply period specified in the 2/5/02 Notice still applies since Applicants to date have not filed an oath/declaration that complies with 37 CFR 1.63. See supra note 2 (The application would become abandoned on 9/6/02 if the maximum extension of 5 months is obtained); and 37 CFR 1.53(f) (If an application which has been accorded a filing date . . . does not include an oath/declaration by the applicant pursuant to §1.63 . . . , applicant will be notified and given a period of time within which to . . . file an oath/declaration . . . to avoid abandonment.).

<sup>10</sup> The 1st month of extension starts on 4/6/02. Refer to [www.uspto.gov](http://www.uspto.gov) for the extension-of-time fee amount. A proper Certificate of Mailing under 37 CFR 1.8 will be recognized in computing the fee owed.

-by mail and by hand: Assistant Commissioner for Patents  
USPTO  
Attn: Office of Petitions  
Crystal Plaza Four, Suite CP4-3C23  
2201 South Clark Place  
Arlington, VA 22202

-by fax: (703) 308-6916  
Attn: Office of Petitions

Finally, the Office acknowledges receipt with the instant petition of the \$130 petition fee and the \$65 surcharge for late filing of the 4/2/02 Declaration (small entity).

Telephone inquiries concerning this decision should be directed to Petitions Attorney RC Tang at (703) 308-0763.



Beverly M. Flanagan  
Supervisory Petitions Attorney  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy

Attachment: Form PTO/SB/01 (10/01)  
(Declaration for Utility or Design Patent Application (37 CFR 1.63))